

**REMARKS**

Claims 1 through 24 are currently pending in the application.

This amendment is in response to the Office Action of October 31, 2006.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Jecha et al. (U.S. Patent No. 7,120,634)**

Claims 1, 2, 5 through 7, and 9 through 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jecha et al. (U.S. Patent No. 7,120,634).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites a method of sending a print job to a printer, comprising: attaching at least one document to an e-mail message; specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes; sending the e-mail message over a network to an e-mail enabled printer, where the e-mail enabled printer includes e-mail client software; and extracting the at least one document from the e-mail message by the e-mail enabled printer.

Applicant asserts that Jecha does not identically describe, either expressly or inherently, each and every element of independent claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Jecha does not describe the element of the claimed invention calling for “specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” Rather, Jecha describes an authentication process for logging onto a web server including associating a user with a particular directory on the server computer, associating the user with a set of defaults regarding options available to the user within an authoring program, and associating the user with an authorization level. Col. 5, lines 26-40. In addition, Jecha describes attaching a translated document as an attachment file to a MIME-compliant electronic mail, which may then be sent to an electronic mail address of a printer. Col. 4, line 65 – Col. 5, line 4. However, there is no reference

whatsoever in Jecha to specifying instructions in a portion of an e-mail message for printing a document with user selected printing attributes.

Furthermore, Applicant asserts that Jecha does not describe the element of the claimed invention calling for “where the e-mail enabled printer includes e-mail client software.” Rather, Jecha describes an authoring program that may be downloaded from a server to a client through the internet. Col. 4, lines 15-32. In addition, Jecha describes a printer that may receive an electronic mail, however, there is no reference whatsoever in Jecha to a printer including e-mail client software.

Therefore, Jecha does not anticipate claim 1 under 35 U.S.C. § 102. Therefore, independent claim 1 is allowable.

Claims 2, 5 through 7, and 9 through 14 are each allowable for depending from claim 1, which is allowable.

Claim 2 is additionally allowable since Jecha fails to describe storing the at least one document in job retention of the e-mail enabled printer by the e-mail enabled printer. Rather, Jecha describes a process in which a user, while logged onto a server, may save a document to the server. Thereafter, the user may select a print command that translates the document into a suitable prepress format and sends the document to the printer. Once the printer receives the document, the document is printed. Col. 5, line 59 – Col. 6, line 2.

Claim 9 is additionally allowable since Jecha fails to describe specifying instructions for the printing comprising providing printer readable language in the portion of the email message. Rather, Jecha describes translating a document into a file format suitable for prepress and thereafter sending the translated document to a printer. Col. 2, lines 1-6; Col. 4, line 65 – Col. 5, line 4; Col. 5, lines 59-64.

Independent claim 15 recites a method of distributing a document for printing, comprising: attaching at a workstation at least one document to an e-mail message; specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes; sending the e-mail message to an e-mail enabled print server of a local network; extracting the at least one document at the e-mail enabled print server; and sending the at least one document to a network printer of the local network by the e-mail enabled print server.

Applicant asserts that Jecha does not identically describe, either expressly or inherently, each and every element of independent claim 15 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Jecha does not describe the element of the claimed invention calling for “attaching at a workstation at least one document to an e-mail message.” Rather, Jecha describes a computerized prepress wherein a client computer logs onto a web server and downloads an authoring program from the server. Col. 5, lines 26-48. The client may then use the authoring program to create a document and save it to the server by selecting a save command. Col. 5, lines 53-55. Thereafter, the server may send an electronic mail to a printer. However, there is no reference whatsoever in Jecha to attaching at a workstation a document to an e-mail message.

Furthermore, Applicant asserts that Jecha does not describe the element of the claimed invention calling for “specifying instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” Rather, Jecha describes an authentication process for logging onto a web server including associating a user with a particular directory on the server computer, associating the user with a set of defaults regarding options available to the user within an authoring program, and associating the user with an authorization level. Col. 5, lines 26-40. In addition, Jecha describes attaching a translated document as an attachment file to a MIME-compliant electronic mail, which may then be sent to an electronic mail address of a printer. Col. 4, line 65 – Col. 5, line 4. There is no reference whatsoever in Jecha to specifying instructions in a portion of an e-mail message for printing a document with user selected printing attributes.

Therefore, Jecha does not anticipate claim 15 under 35 U.S.C. § 102. Therefore, independent claim 15 is allowable.

Claims 16 through 18 are each allowable for depending from claim 15, which is allowable.

Claim 17 is additionally allowable since Jecha fails to describe storing the at least one document in job retention of the network printer. Rather, Jecha describes a process in which a user, while logged onto a server, may save a document to the server. Thereafter, the user may select a print command that translates the document into a suitable prepress format and then sends the document to the printer. Once the printer receives the document, the document is printed. Col. 5, line 59 – Col. 6, line 2.

Independent claim 19 recites a system for receiving and distributing a remotely sent print job to a network printer, comprising: an e-mail enabled print server device for communication with a network, the e-mail enabled print server configured for receiving from a remote workstation an e-mail message having a document sent as a print job attached thereto, instructions specified in a portion of the email message for printing the at least one document with user selected printing attributes, the e-mail enabled print server configured for extracting the document from the e-mail message and for transmitting the document to at least one network printer device; and a network printer device configured to be communicatively coupled to the e-mail enabled print server device over the network, the network printer device configured for storing and for printing print jobs transmitted by the e-mail enabled print server device.

Applicant asserts that Jecha does not identically describe, either expressly or inherently, each and every element of independent claim 19 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Jecha does not describe the element of the claimed invention calling for “instructions specified in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” Rather, Jecha describes an authentication process for logging onto a web server including associating a user with a particular directory on the server computer, associating the user with a set of defaults regarding options available to the user within an authoring program, and associating the user with an authorization level. Col. 5, lines 26-40. In addition, Jecha describes attaching a translated document as an attachment file to a MIME-compliant electronic mail, which may then be sent to an electronic mail address of a printer. Col. 4, line 65 – Col. 5, line 4. However, there is no reference whatsoever in Jecha to specifying instructions in a portion of an e-mail message for printing a document with user selected printing attributes.

Furthermore, Applicant asserts that Jecha does not describe the element of the claimed invention calling for “the network printer device configured for storing and for printing print jobs transmitted by the e-mail enabled print server device.” Rather, Jecha describes a printer with a processor, a computer-readable medium from which computer programs are executed by the processor, and a communications device, such as a network card or modem. The printer may be networked together with a server computer and a client computer and may receive a translated document as an electronic mail. Col. 3, lines 55-67. Upon receipt of the document, the printer prints the document. Col. 5, lines 6-8.

Therefore, Jecha does not anticipate claim 19 under 35 U.S.C. § 102. Therefore, independent claim 19 is allowable.

Claim 20 is allowable for depending from claim 19, which is allowable.

Independent claim 21 recites a computer system for processing print jobs, comprising: an e-mail enabled device for creating and sending e-mail with attachments, the e-mail comprising instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes; an e-mail enabled printer incorporating e-mail client software for receiving e-mails, extracting attachments from said e-mails, and printing said attachments; and a network for communicating e-mail between said e-mail enabled device and said e-mail enabled printer.

Applicant asserts that Jecha does not identically describe, either expressly or inherently, each and every element of independent claim 21 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Jecha does not describe the element of the claimed invention calling for “the e-mail comprising instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” Rather, Jecha describes an authentication process for logging onto a web server including associating a user with a particular directory on the server computer, associating the user with a set of defaults regarding options available to the user within an authoring program, and associating the user with an authorization level. Col. 5, lines 26-40. In addition, Jecha describes attaching a translated document as an attachment file to a MIME-compliant electronic mail, which may then be sent to an electronic mail address of a printer. Col. 4, line 65 – Col. 5, line 4. There is no reference whatsoever in Jecha to specifying instructions in a portion of an e-mail message for printing a document with user selected printing attributes.

Furthermore, Applicant asserts that Jecha does not describe the element of the claimed invention calling for “an e-mail enabled printer incorporating e-mail client software.” Rather, Jecha describes an authoring program that may be downloaded from a server to a client through the internet. Col. 4, lines 15-32. In addition, Jecha describes a printer that may receive an electronic mail. However, there is no reference whatsoever in Jecha to a printer including e-mail client software.

Therefore, Jecha does not anticipate claim 21 under 35 U.S.C. § 102. Therefore, independent claim 21 is allowable.

Claims 22 and 23 are each allowable for depending from claim 21, which is allowable.

Claim 22 is additionally allowable since Jecha fails to describe an e-mail enabled printer including a job retention memory for storing print jobs.

Independent claim 24 recites a computer system for processing print jobs, comprising: a local or remote workstation for creating and sending e-mail with attachments, the e-mail comprising instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes; an e-mail enabled print server for receiving said e-mail with attachments, extracting said attachments from said e-mail, and sending said

attachments for printing; a network printer for receiving and printing said attachments extracted from said e-mail by said e-mail enabled print server; and a network for facilitating communications between said e-mail enabled device, said e-mail enabled server, and said network printer.

Applicant asserts that Jecha does not identically describe, either expressly or inherently, each and every element of claim 24 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Jecha does not describe the element of the claimed invention calling for “the e-mail comprising instructions in a portion of the e-mail message for printing the at least one document with user selected printing attributes.” Rather, Jecha describes an authentication process for logging onto a web server including associating a user with a particular directory on the server computer, associating the user with a set of defaults regarding options available to the user within an authoring program, and associating the user with an authorization level. Col. 5, lines 26-40. In addition, Jecha describes attaching a translated document as an attachment file to a MIME-compliant electronic mail, which may then be sent to an electronic mail address of a printer. Col. 4, line 65 – Col. 5, line 4. There is no reference whatsoever in Jecha to specifying instructions in a portion of an e-mail message for printing a document with user selected printing attributes.

Therefore, Jecha does not anticipate claim 24 under 35 U.S.C. § 102. Therefore, independent claim 24 is allowable.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### **Obviousness Rejection Based on Jecha et al. (U.S. Patent No. 7,120,634) in view of Maruyama (U.S. Patent No. 7,016,057)**

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jecha et al. (U.S. Patent No. 7,120,634) in view of Maruyama (U.S. Patent No. 7,016,057). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant further submits that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Claims 3 and 4 are each allowable for depending from claim 1, which is allowable.

Obviousness Rejection Based on Jecha et al. (U.S. Patent No. 7,120,634) in view of Fabbio et al. (U.S. Patent No. 5,870,089)

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Jecha et al. (U.S. Patent No. 7,120,634) in view of Fabbio et al. (U.S. Patent No. 5,870,089). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 8 is allowable for depending from claim 1, which is allowable.

Applicant submits that claims 1 through 24 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 1 through 24 and the case passed for issue.

Respectfully submitted,



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